REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

Claims 14-15 are pending in the present application before this amendment. By the present amendment, claim 14 has have been amended. No new matter has been added.

In the office action, claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,181,174 (Fujieda) in view of U.S. Patent No. 6,360,328 (Muraki). The "et al." suffix in a reference name is omitted.

The applicant respectfully agrees with the statement in the office action page 2 that Fujieda fails to teach or suggest the claimed feature of outputting a first clock signal in a power down condition and producing a second clock signal (having a higher frequency than the frequency of the first clock signal) during a non-power down mode. In fact, Fujieda is completely silent about the claimed feature and never teaches or suggests controlling power consumption through reduction of frequency.

To make up for this failure of teachings or suggestions in Fujieda, the examiner cites Muraki col. 1, lines 41-45; however, the applicant respectfully asserts that even if these two references are combined, the presently claimed invention is still not taught or suggested.

Claim 1 has been amended to more clearly claim one feature of the present invention that includes, inter alia, a power down controller (see FIG. 4, 400) that determines the power down condition based at least on the control signal such as the clokc enable signal (see FIG. 4, CKE) that is inputted to the Digital Delay Line that

includes the clock divider.

First, therefore, not every claimed limitation is taught or suggested by Fujieda or Muraki, whether these references are considered individually or in combination. As the examiner is aware, it is well founded in the patent case law and consistently in MPEP that the Examiner bears the **initial** burden of **factually** supporting any prima facie conclusion of obviousness. MPEP §2142. One of three requirements required to establish the prima facie case of obviousness is that the prior art references **must** teach or suggest **all** the claim limitations. MPEP §2143.03.

In the present case, even if Fujieda and Muraki are combined, the following limitation now recited in claim 1 is not taught or suggested:

> --a power down controller for determining a power down condition based at least on a predetermined state of a clock enable signal inputted to the DLL--.

As already discussed above and acknowledged by the examiner, Fujieda is just silent on the claimed power down controller. The cited Muraki col. 1, lines 41-45, merely makes some suggestions in very general term that "Various means for power down control are employed, such as ... reduce the frequency of the clock" but this is pretty much the extent of the Muraki's disclosure. Nowhere in Muraki teaches or discloses the claimed power down controller determining the power down condition based at least on the clock signal inputted to the DLL. More importantly, Muraki is not directed to a circuit utilizing a DLL, and therefore just cannot teach claim 1. At least on this ground, claim 1 is respectfully submitted to be allowable, because the cited Fujieda and Muraki just does not teach or suggest all claimed limitations, even if they are considered in combination.

Sometimes the examiner mistakenly ignores a phrase in a claim limitation that begins with "for performing something" language as in –a power down controller **for determining ...**– on grounds that such phrase relates to something functional. The applicant respectfully notes MPEP §2173.05(g), which makes it **very clear** that:

> "There is **nothing inherently wrong** with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F2d 210, 169 USPQ 226 (CCPA 1971)."

In fact, the same section of MPEP **requires** that the functional claims should be treated as and be examined "just like any other limitation of the claim":

> "A functional limitation **must** be evaluated and considered, **just like any other limitation** of the claim, for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used." MPEP §2173.05(g).

Second, the second criteria required by the examiner in order to establish the prima facie case of obviousness is that there must be some suggestion or motivation, either **in the references themselves** or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143.01. The mere fact that the teachings of the prior art **can** be modified or combined does **not** establish a motivation or suggestion to combine and make the resultant combination prima facie obvious. The prior art must suggest the desirability of the combination. The suggestion or motivation to combine references must come from the cited prior art references, either explicitly or implicitly. MPEP §2143.01.

Fujieda provides no sufficient suggestion or motivation as Fujieda is just silent on the claimed power down controller. Muraki also lacks the sufficient suggestion or motivation for combination with other references such as Fujieda to teach the presently

claimed invention, because Muraki's subject matter is not at all directed to DLL. Thus, this is another failure to establish the prima facie case of obviousness, since Fujieda and Muraki does not provide sufficient support in the references themselves for the required suggestion or motivation required for combination of cited references.

For the reasons set forth above, the applicant respectfully submits that claims 14-15, now pending in this application, are in condition for allowance over the cited references. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and earnestly solicits an indication of allowable subject matter. This amendment is considered to be responsive to all points raised in the office action. Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

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